

In the Office Action dated June 9, 1999, Applicant was advised that the application fails to comply with the requirements of 37 C.F.R. § 1.825. In response, Applicant is filing concurrently herewith an Amendment to provide compliance for the application with 37 C.F.R. § 1.825.

Also in the Office Action, claims 5 and 6 were provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 34 and 56 of copending application No. 08/751,300. This rejection is respectfully traversed for the following reasons.

Initially, Applicant respectfully calls the Examiner's attention to the recent issuance of a patent from U.S. Application No. 08/751,300, namely U.S. Patent 5,962,407 which issued on October 5, 1999. A copy of the issued patent is enclosed for the Examiner's convenience.

Claims 5 and 6 of the presently pending application recite as follows,

5. A pharmaceutical composition comprising a compound of claims 1, 2, 3 or 4 and a pharmaceutically acceptable carrier.

6. A method for the treatment of a patient afflicted with a bacterial infection comprising the administration to said patient of a therapeutically effective amount of a compound of claims 1, 2, 3, or 4.

Claims 1-4, as referred to in claims 5 and 6, recite as follows:

1. An isolated compound selected from the group consisting of:
cyclo [L-Val-L-Orn-L-Leu-D-Tyr-L-Pro-L-Phe-D-Phe-L-Asn-L-Asp-L-Tyr];
cyclo [L-Val-L-Orn-L-Leu-D-Tyr-L-Pro-L-Phe-D-Phe-L-Asn-L-Asp-L-Trp]; and
cyclo [L-Val-L-Orn-L-Leu-D-Tyr-L-Pro-L-Trp-D-Phe-L-Asn-L-Asp-L-Trp].

2. A compound of claim 1 having the formula:
cyclo [L-Val-L-Orn-L-Leu-D-Tyr-L-Pro-L-Phe-D-Phe-L-Asn-L-Asp-L-Tyr].

3. A compound of claim 1 having the formula:
cyclo [L-Val-L-Orn-L-Leu-D-Tyr-L-Pro-L-Phe-D-Phe-L-Asn-L-Asp-L-Trp].

4. A compound of claim 1 having the formula:
cyclo [L-Val-L-Orn-L-Leu-D-Tyr-L-Pro-L-Trp-D-Phe-L-Asn-L-Asp-L-Trp].

In contrast, claims 34 and 56 of U.S. Patent 5,962,407 recite as follows:

34. A pharmaceutically acceptable derivative of a poly(amino acid) compound selected from the group consisting of:

cyclo[Val-Orn-Leu-Tyr-Pro-Phe-Phe-Asn-Asp-Tyr] (SEQ ID NO:76);
cyclo[Val-Orn-Leu-Tyr-Pro-Phe-Phe-Asn-Asp-Trp] (SEQ ID NO:77); and
cyclo[Val-Orn-Leu-Tyr-Pro-Trp-Phe-Asn-Asp-Trp] (SEQ ID NO:78) wherein the derivative is an ether derivative of an amino acid sidechain containing a hydroxyl group, or an ester derivative of an amino acid sidechain containing a carboxylic acid group or amide derivative of an amino acid sidechain containing a carboxylic acid group.

56. A method for the treatment of a patient afflicted with a bacterial infection comprising the administration to said patient of a therapeutically effective amount of a compound, derivative or salt of any of claims 1-4, 9-12, 25-31 or 34-40.

Claims 1-4, 9-12, 25-31 and 34-40 as referred to in claim 56 are too numerous to conveniently reproduce, however they are set forth in the enclosed U.S. Patent 5,962,407. As can be seen from the foregoing recitation of the claims, as well as by reference to U.S. Patent 5,962,407, the present application is directed to compositions and methods of treatment using three specific decapeptides. In contrast, claims 34 and 56 in U.S. Patent 5,962,407 are directed to using various decapeptide derivatives, and not the decapeptide themselves, in compositions and methods.

Under 35 U.S.C. § 101, an Applicant may not obtain two patents for the identical invention. However, in the present instance, the coverage is necessarily non-identical, as the

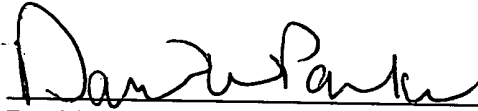
claims in the present application are directed to three decapeptides, while in the issued patent the claims are directed to derivatives etc. of these three decapeptides. Accordingly, issuance of a patent for the presently pending claims would not provide Applicant with two patents for the identical invention. Reconsideration and withdrawal of the rejection are therefore respectfully requested.

Claims 1-4 stand provisionally rejected as being unpatentable over claim 54 of co-pending application number 08/751,300, now U.S. Patent 5,962,407. While Applicant does not agree with this rejection, Applicant is seeking to obtain a Terminal Disclaimer to obviate the rejection. The executed Terminal Disclaimer will be provided to the Examiner in the very near future.

If any issue requires further discussion, the Examiner is encouraged to contact the undersigned to resolve the matter, at 206-622-4900.

Respectfully submitted,

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DWP:scc

Enclosures:

- Postcard
- Computer Diskette
- Check
- Form PTO-1083 (+ copy)
- Petition for an Extension of Time (+ 2 copies)
- Copy of U.S. Patent No. 5,962,407
- Amendment Regarding Sequence Disclosures
- Declaration Regarding Computer Diskette
- Paper Copy of Sequence Listing (35 pages)
- Copy of Notice to Comply

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